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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,249	10/03/2003	Gary William Yeager	133816-1	2016
23413	7590	11/10/2005	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			TRUONG, DUC	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/678,249	YEAGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Duc Truong	1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10,11,13-26 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-11, 13-26 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

Per conversation with Applicant on October 31, 2005, Applicant wants to know why the Office action mailed on September 19, 2005 has been withdrawn.

The Advisory action has been mailed on 8/29/05 and Applicant filed the Amendment AF on 9/9/05 and Examiner has only 10 days to respond to this Amendment and an Office action has been issued on 9/19/05. However, an RCE has been filed three days later, 9/22/05, the status of the case has been changed and the 9/19/05 Office action is no longer valid and hereby withdrawn in order for RCE to be entered into the system.

Therefore, a new ground of rejection is cited herein:

Claims 1-8, 10-11, 13-26 and 29 –32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merfeld et al.

The reference discloses a curable composition comprising a functionalized poly(arylene ether) see [0014], which has been capped by the structure [0015 et seq.], maleic anhydride [0031], an olefin alkyl (meth)acrylate copolymer such as ethylene ethyl acrylate copolymer [0081, 0084], an alkenyl aromatic monomer (see Abstract, [0047-0049] may comprise polybutadiene [0068].

The composition may further comprising an additive selected from flame retardants, lubricants, antioxidants, thermal stabilizers, ultraviolet stabilizers, pigments, dyes, anti-static agents---[0119], suitable to form articles [0133-0134].

The disclosure of the reference differs from the instant claims in that it does not disclose the claimed olefin alkyl (meth)acrylate excluding ethylene ethyl acrylate (C2).

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However, said copolymers (C2) has the same functionality with other ethylene (C1 and C3-C8) acrylate copolymers in the same composition due to the same mechanism to form the same or similar products. Therefore, it would have been obvious to one of ordinary skill in the art to select the ethylene C2 acrylate copolymer from the reference to replace ethylene C1 and C3-C8 acrylate copolymers in the claimed composition since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said use.

The Declaration under 37 CFR 1.132 filed 9/09/05 is insufficient to overcome the rejection of claims 1-8, 10-11, 13-26 and 29-32 based upon a specific reference applied under 35 U.S.C. 103 as set forth in the last Office action because: fails to set forth facts related to the invention.

Because reference is a joint Patent Published Application to Applicant and another, then an unequivocal declaration under 35 CFR 1.132 must be filed by S that he conceived or invented the subject matter disclosed in the application publication and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). However, said declaration is insufficient to show the relevant portions of the reference originated with or were obtained from applicant in that neither relevant dates nor conception have been detailed. MPEP 716.10.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10-11, 13-26 and 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,22, and 28-35 of U.S. Patent No. 6,878,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is the instant claim 1 is the combination of claims 1 and 22 of the reference in that the ethylene ethyl acrylate copolymers in claim 22 is included in a polymeric additive in claim 1 of the reference.

Therefore, it would have been obvious to one of ordinary skill in the art to combine claims 1 and 22 of the reference to form at least claims and seq. of the instant claims since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DUCTRUONG  
PRIMARY EXAMINER